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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,511	10/06/2000	Raymond Andersen	108281-00000	6795

4372 7590 11/08/2007

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EXAMINER	
LUKTON, DAVID	
ART UNIT	PAPER NUMBER
1654	

NOTIFICATION DATE	DELIVERY MODE
11/08/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary	Application No.	Applicant(s)	
	09/581,511	ANDERSEN ET AL.	
	Examiner	Art Unit	
	David Lukton	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-25,27,29,31-66 and 68-78* is/are pending in the application.

4a) Of the above claim(s) *24,27,29,34,36,59,60,62 and 74* is/are withdrawn from consideration.

5)☒ Claim(s) *51,58,61,63-66,71,72 and 76* is/are allowed.

6)☒ Claim(s) *23,25,31-33,35,37-50,52-57,68-70,75,77 and 78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/07 has been entered.

. . . .

Pursuant to the directives of the amendment filed 6/18/07, several claims have been amended. Claims 23-25, 27, 29, 31-66, 68-78 remain pending.

Claims 24, 27, 29, 34, 36, 59, 60, 62, 74 remain withdrawn from consideration.

The following claims are examined in this Office action: 23, 25, 31-33, 35, 37-58, 61, 63-66, 68-73, 75-78.

Applicants' arguments filed 6/18/07 have been considered and found persuasive in part. For purposes of this Office action, the characterization of "allowable" is applied to each of the following claims: 51, 58, 61, 63-66, 71, 72, 76.

Applicants' arguments filed 6/18/07 have been considered and found not persuasive.

✧

Claims 23, 25, 31-33, 35, 37-50, 52-57, 68-70, 75, 77-78 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 23, variable "R" is defined in two different ways. In claim 23, a few lines of text

following formula I, the following is recited:

> "wherein the definition of R is limited to a ... moiety having a linear.... skeleton and the carbon atoms are optionally substituted with ...[etc.]".

If one then proceeds down another 9 lines (or so) from here, one finds a very different definition of "R", i.e., the following:

> "R is defined as a ... moiety having a linear.... skeleton containing 1-10 carbon atoms, 0-4 nitrogen atoms, 0-4 oxygen atoms,... and the carbon atoms are optionally substituted with oxo, thio-oxo, hydroxyl, [etc.].

The same issue as the foregoing applies in the case of claims 25, 44, 47, 68, 69, 70, 73, 75. This is the most important issue in this application at the present time. It is suggested that applicants amend the claims to make it very clear exactly what variable "R" is supposed to be.

- In claim 35, immediately following the structural formula, the following is recited:

> R_1 and R_2 are ... selected from... provided that if either one of R_1 and R_2 is H, each of R_3, R_4, R_6 and R_8 are hydrogen, and R_5 is isopropyl or phenyl and R_7 is methyl or benzyl.

One way to interpret this phrase in the claim is that if one of R_1 and R_2 is H, it then follows therefrom that **all** of the following must be true: (a) each of R_3, R_4, R_6 and R_8 must be hydrogen, (b) R_5 must be isopropyl or phenyl and (c) R_7 can be nothing other than methyl or benzyl. However, immediately following this definition of R_3, R_4, R_6, R_8, R_5, and R_7 (for the case of R_1 or R_2 being hydrogen), the claim proceeds to define these variables very differently. Thus, there is an important contradiction. If consistent with applicants' intentions, the proviso should be added <u>following</u> the definition of R_3, R_4, R_6, R_8, R_5, and R_7, which would help to convey that the proviso supercedes the definition, when certain conditions are met. The same issue applies in the case of claims 37 and 38.

✦

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

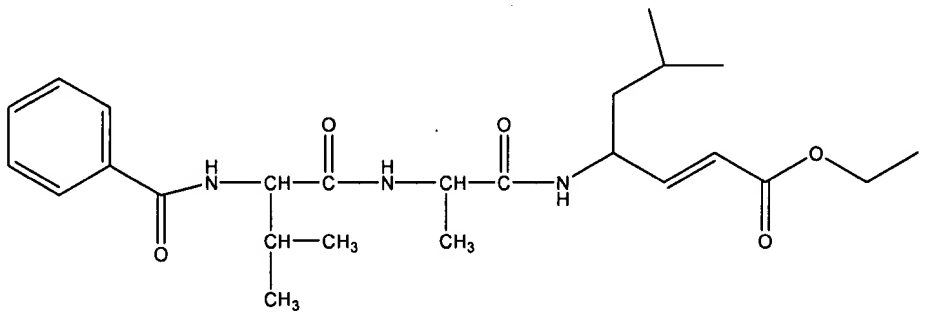
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23, 25, 44, 47, 53, 68-70, 73, 75 are rejected under 35 U.S.C. §102(a) as being anticipated by Johnson (WO 97/04004).

As indicated previously, Johnson discloses compound 26 (page 74), which has the following structure:



This compound is encompassed by the claims when the substituent variables are as follows:

R1 = benzoyl;
R2 = hydrogen;
R3 = methyl;

R4 = methyl;
R5 = hydrogen;
R6 = hydrogen
R7 = methyl
R8 = hydrogen
Y = propylene substituted with isobutyl
Z = $-O-CH_2-CH_3$

In response, applicants have made various arguments. However, given the high level of ambiguity in the claims, as indicated above in the §112, second paragraph rejection, this rejection will be maintained at the present time. In the even that the §112, second paragraph issues are resolved, this ground of rejection will be revisited.

✧

Claim 23, 25, 31, 44, 47, 53, 68-70, 73, 75 rejected under 35 U.S.C. §102(b) as being anticipated by Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995).

As indicated previously, Falender discloses the following compound on page 134 ("Ag" represents allylglycine):

Ag-Phe-Phe-Ag-OEt

Applicants have traversed the rejection. This rejection will be maintained pending resolution of the §112, second paragraph issues.

✧

The following is a quotation of 35 USC. §103 which forms the basis for all obviousness

rejections set forth in the Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 23, 25, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Johnson (WO 97/04004).

The teachings of Johnson are indicated above, and previously. Applicants have traversed the rejection. This rejection will be maintained pending resolution of the §112, second paragraph issues.

✦

Claims 23, 25, 31, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995). As indicated previously, Falender discloses the following compound on page 134 ("Ag" represents allylglycine):

Ag-Phe-Phe-Ag-OEt

Applicants have traversed the rejection. This rejection will be maintained pending resolution of the §112, second paragraph issues.

✦

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

D. Lukton

DAVID LUKTON, PH.D.
PRIMARY EXAMINER